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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/470,571	06/06/1995	JOHN C. HARVEY	5634.261	7586

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EXAMINER	
HARVEY, DAVID E	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	08/470,571	HARVEY ET AL.	
	Examiner	Art Unit	
	DAVID E HARVEY	2614	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *20 September 2004*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attachment*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *all*.

Claim(s) withdrawn from consideration: _____.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

DAVID E HARVEY
Primary Examiner
Art Unit: 2614

A) It has come to the examiner's attention that he made a significant error when stating the "facts" of the instant prosecution in part "1)" of section "I." of the last advisory action mailed 11/2004. As such, the arguments made in said part "1)" are hereby withdrawn and "replaced" by the following:

1) The "*user specific*" terminology:

A) It appears that the "user specific" terminology was first introduced into the record via the amendment filed 10/15/1984 in applicants' original 1981 parent application SN 06/317,510 (i.e. US Patent No. 4,694,490). In the arguments of this amendment, the meaning/significance of the added "user specific" terminology was described as follows:

> **"Applicant's invention enables the program content of a television program to be modified in a *unique* manner for each of a multiplicity of users (or viewers) by causing microprocessors located at the respective subscriber stations to generate video signals in response to a control signal in the transmitted video program material. In applicant's invention, the overlay video information is *specific to the user* and directly related to the video program material. For example, in the case of a program such as "WALL STREET WEEK," the invention may be used to display investment information unique to a subscriber at the subscriber's station and at a precise point in the course of the program at which *the specific information of the user* relates directly to the transmitted information of more general public interest. As a more specific example, the performance of each user's investment portfolio may be displayed at the user's TV set at a point during the program when each subscriber is asked to compare the performance of his or her own portfolio with measures of the overall performance of the general market"**
> [SEE the first full paragraph on page 5 of the amendment filed 10/15/1984 in SN 06/317,510, now US Patent #4,694,490]

This argument implies that it is the "user specific" nature of the entered user data (and overlay generated therefrom) that causes the program content of the television program to be modified in a fashion that makes it "unique." Clearly, if the modified program content is "unique", then the user data and overlay generated therefrom must be "unique" too; i.e. the TV program material is certainly not "unique."

B) In continuation application SN 06/829,531 (patent #4,704,725), which contains the same 1981 parent specification, the modified TV signal resulting from the "user specific" overlay was claimed as being "unique" throughout the prosecution thereof. Then, in a 312 amendment filed 8/12/1987, applicants' amended the claims so as to replace the "unique" terminology with "user specific terminology". The reason for this change was explained as follows:

> **"The foregoing amendments are proposed to correct an inadvertent oversight and to make the claims internally consistent. The language which applicants propose to amend in claims 18 and 21 state that each output signal is "unique to a specific user". However, the preamble of each claim refers to "user specific signals" and the crux of the invention lies in the ability to output signals that are specific (not necessarily 'unique' to specific users (subscribers). In other words it is the fact that the outputs relate specifically to a given user that is important, not whether or not the outputs are "unique". The term "unique" may imply that each output is different which, as explained in the parent application, is not necessarily the case so long as the outputs are specific to the individual users.**
> **The foregoing error was noticed only recently. Applicants submit that the proposed amendment is proper in accordance with the provisions of Rule 312 since it involves no change in scope and merely clarifies a term which, possibly, may be misdescriptive."**
> [SEE the 312 amendment filed 8/12/1987 in SN 06/829,531 (US #4,704,725)]

Here, applicants clearly argue that the "user specific" terminology does not mean "unique". That is, applicants allege that the user data entered at least some of the different stations (and the display/overlay generated therefrom) are *inherently* the same. Based on this allegation, applicants proceeded to amend claims, via said 312 amendment, to replace the alleged inaccurate "unique" terminology with alleged more accurate "specific" terminology. According to applicants, the "specific" terminology now accurately encompassed the *alleged inherent* [1] situations in which the entered "user data" at the different receiver stations/locations was the "same" and, therefore, merely "user specific"; i.e. not "unique" as described and previously claimed.

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[1] If this were not the case, then changing "unique" to "specific" would have represented the improper insertion of "New Matter".

C) *Throughout the prosecution of the instant application (SN 08/470,571)*, the examiner has maintained that the input of "user specific" data recited in applicant's claims properly and fairly reads on the input of Teletext page selection data at conventional Teletext receiving stations. That is, Teletext page selection data entered by each user at each Teletext receiving station, while not necessarily "unique" to the user, is nonetheless "specific" to the user. For example:

1) Each of the entered Teletext page numbers is "user specific" in that each entered number is personally selected and entered by the respective user to identify the specific page of Teletext data that is "specifically" desired and "specifically" requested by the respective user who entered it into their respective Teletext receiver station;

2) Each of the entered Teletext page numbers is also "user specific" in that each number comprises a digital code that has been "specified", and individually keyed in, by the user at a respective receiver station;

3) etc,...

D) Ironically, in the latest response (part "E." of the response filed 9/2004 in 08/470,571), applicant goes so far as to suggest that the "specific" terminology of the instant claims should be read as being synonymous with the previously alleged inaccurate "unique" terminology that it replaced (note part "B" above):

> **"As properly construed, there is nothing 'user specific' about a page number entered by a user in a teletext system. All users of a given teletext system would enter the *same* page number to get the *same* teletext page. No page number can possibly be *unique* to a user."** [2] (emphasis added)
> [The second full paragraph on the page 22 of the response filed 9/2004]

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[2] That is, applicants replaced the "unique" terminology with "specific" terminology for the specific purpose of covering situations in which the entered data was the "same." Hence, applicants' current suggestion that the "specific" terminology requires the entered "user specific" data to be different/"unique" makes no sense.

With respect to applicants' argument, the following was noted:

1) Contrary to applicants' latest suggestion, the record shows that the recited "user specific" terminology was intended to cover situation in which the user data entered at different station was "same" and not "unique";

2) The fact that a user of a conventional Teletext system enters the same Teletext page number into his/her respective receiver when his/her desires the *same* "user specific" Teletext page as desired by another user, is irrelevant to the issue at hand. That is, regardless of the value of the page data that is entered, each user of conventional Teletext systems desires their own "user specific" page of Teletext data and enters their own corresponding "user specific" page number into their respective receiver station to identify the "specific" page that they desire (i.e. wherein, at any given time, the page desired and selected by a user may be the *same* or *unique* with respect to the "user specific" pages desired and selected by the other users).[3]
Further, even in the case of applicants' own system respective users must enter the *same* portfolio data to generate the *same* overlay/display in situation when their respective portfolios are the *same* [i.e. the reason why applicants amended their original specification by replacing the alleged inaccurate "unique" terminology with the alleged more accurate "specific" terminology via said 312 amendment]. Thus, for applicants to suggest that the "user specific" terminology should be read as excluding situations in which the user-entered data can be the *same*, and not *unique*, is nonsense [i.e. it is contrary to, and flies in the face of, the instant prosecution history].

3) The "user specific" terminology is little more than a label. This label has been properly and fairly interpreted by the instant examiner, consistently throughout the extensive file history, as reading on the page selection process of applied teletext "prior art" for the reasons discussed above. Each entered page number represents respective "user specific" page selection data!

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[3] The entered Teletext page number is "unique" to the user whenever a user's selected/inputted page number differs from the page numbers selected/inputted by any of the other users (i.e. which is not an improbable situation given the fact that a typical Teletext system typically carries hundreds, even thousands, of pages of popular and unpopular Teletext data.

E) Additionally, in lines 8-10 on page 20 of the response filed 9/2004 in SN 08/470571, applicants' also allege that the recited term "user specific data" (and variants thereof) should be construed to mean:

> **"[D]ata that relates to a particular receiver station or to the user or users of that receiver station, and which may be, but does not necessarily have to be unique to that particular station or users."** [4]

Even if adopted, this definition fails to distinguish that which is claimed over the Teletext prior art. That is, the "user data" that is inputted by a user of a Teletext receiver station in order to request the receipt and display of the desired page of Teletext data, is "user specific data" even in the context of applicants own cited definition; i.e. the data that is entered by the user of a Teletext receiver clearly "relates" to the particular user in that it literally identifies the specific page of Teletext data that said user desires and that said user has specifically requested. What is more "user specific" than input data that is actually specified by the user?

F) Given the above, the following is noted:

1. As noted in part "A" above, it appears that the "user specific" terminology was implicitly defined to means "unique" within parent application SN 06/317,510;

2. As noted in part "B" above, in SN 06/829,531, it appears that the same "user specific" terminology was explicitly defined as only being "specific" to the user; i.e. and not necessarily "unique" to the user;

3. As noted in parts "D" and "E" above, in the present application *(SN 08/470,571)*, it now appears that applicants want the "user specific" terminology to simultaneously have all the meanings/definitions cited above and more. That is, taken as a whole, it appears that applicants now alleged that the "user specific" terminology should be interpreted as meaning:

   a. Data that is "unique" to the *user* and yet not necessarily "unique" to the *user*; and

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[4] Here, it is interesting to note that applicants wish to broadly define the "user specific" terminology in a way that includes/encompasses "receiver specific" data too.

b. Data that may not be "user specific" at all, but may only be "receiver specific".

As to the meaning of this new "receiver specific", if one follows the same line of reasoning argued by applicants for the "user specific" terminology, one arrives at:

a. Data that is "unique" to the *receiver* yet not necessarily "unique" to the *receiver*; and

b. Data that may not be "receiver specific" at all; e.g. may be "user specific" and more(?).

G) Further, while not necessarily at issue, applicants are correct in that the examiner does believe that the "user specific data" label is itself so broad, even as defined by applicants in the present prosecution history, that it:

> **"[I]nvites rejections based on references that simply disclose user selection of an option from a list of available choices"**
> ***[note lines 2 and 3 on page 20 of the response filed 9/2004]***

That is, the examiner believes that "data" that is inputted by a user to identify the "option" that he/she has selected, even if made from a limited list of choices, is "user specific data". That is, even In accordance with applicant's own definition, such input data "relates to the user" in that it is inputted by the user and it represents the specific choice/desire of that user. Additionally, such "user specific selection data" may even be "unique" to the given user depending on the selections/choices made by the "other" users (i.e. depending on whether or not any of said other users made inputted data corresponding to the same choice/selection).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E HARVEY whose telephone number is (703) 305-4365. The examiner can normally be reached on M-F from 6 AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID E HARVEY
Primary Examiner
Art Unit 2614